1 The opinion in support of the decision being entered today was *not* written for
2 publication and is *not* binding precedent of the Board.
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6 UNITED STATES PATENT AND TRADEMARK OFFICE
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9 BEFORE THE BOARD OF PATENT APPEALS
10 AND INTERFERENCES
11 _____
12
13 *Ex parte* GERALD FRANCIS MCBREARTY, SHAWN PATRICK MULLEN,
14 and JOHNNY MENG-HAN SHIEH
15 _____
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17 Appeal No. 2007-0731
18 Application No. 09/899,454
19 Technology Center 2100
20 _____
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22 Decided: April 24, 2007
23 _____
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25 Before ANITA PELLMAN GROSS, STUART S. LEVY, and ROBERT E. NAPPI
26 *Administrative Patent Judges.*
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28 NAPPI, *Administrative Patent Judge.*
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31 DECISION ON APPEAL
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33 This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of

34 claims 1 through 36. For the reasons stated *infra* we affirm the Examiner's

35 rejection of these claims.

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INVENTION

The invention is directed to a method of presenting bookmarks with a web browser. The system provides information relating to the activity rate of a particular bookmarked web site when the user views their bookmarks. This way the user can choose to access the web site at a different time if there is significant activity. See page 3 of Appellants' Specification. Claim 1 is representative of the invention and reproduced below:

> 1. In a World Wide Web (Web) communication network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext documents of at least one display page containing text and images transmitted from sources on the Web, a system for bookmarking of selected received Web documents comprising:
> means associated with one of said receiving display stations for bookmarking of selected received Web documents to thereby store at said receiving display station, direct links to the sources of said Web documents;
> means for tracking the rates of said bookmarked Web documents transmitted from each of said sources during daily time cycles; and
> means at said receiving display station for displaying in association with a displayed list of bookmarks for Web documents, data on the rates of transmission of said bookmarked documents at the time of said display.

REFERENCES

The references relied upon by the Examiner are:

Burke	US 6,032,162	Feb. 29, 2000
Pitkow	US 2002/0016786 A1	Feb. 7, 2002 (filed Dec. 4, 2000)
Ryan	U.S. 6,421,675 B1	Jul. 16, 2002 (filed Jul. 15, 1998)

1   Additional reference relied upon by the Board of Patent Appeals and

2

3   Interferences

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5   Pitkow   US 7,031,961 B2   Apr. 18, 2006

6   (filed Dec. 4, 2000)

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8   REJECTION AT ISSUE

9   Claims 1 through 6, 8 through 18, 20 through 30, and 32 through 36 stand

10 rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan and Pitkow. The

11 Examiner's rejection is set forth on pages 3 through 9 of the Answer. Claims 7,

12 19, and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ryan,

13 Pitkow, and Burke. The Examiner's rejection is set forth on page 10 of the

14 Answer. Throughout the opinion we make reference to the Brief and Reply Brief

15 (filed March 28, 2006 and August 14, 2006 respectively), and the Answer (mailed

16 June 14, 2006) for the respective details thereof.

17   ISSUES

18   Appellants contend that the Examiner's rejection based upon Ryan and

19 Pitkow under 35 U.S.C. § 103(a) is in error. Specifically, Appellants argue that

20 Ryan teaches use of tracking transmission rates only in the context of search

21 engine algorithms. Appellants further argue that there is no suggestion in Ryan to

22 display the transmission rates of bookmarked documents at a receiving station.

23 (Br. 7, Reply Br. 2-3). Appellants assert that Pitkow does not make up for this

24 deficiency. (Br. 8).

25   The Examiner contends that the rejection is proper. The Examiner states

26 that Ryan's "Personal hit-lists" suggests using Ryan's system with bookmarks, and

27 that Pitkow teaches using bookmarks at a web page receiving station. The

1   Examiner therefore asserts that it would have been obvious to combine the

2   references to arrive at the invention.

3   The Appellants' contention presents us with the issue of whether Pitkow and

4   Ryan provide sufficient evidence to show that it would have been obvious to a

5   skilled artisan to display with a list of bookmarks, data rates of transmission of said

6   bookmarked documents.

7   FINDINGS OF FACT

8   Pitkow teaches a system for storing and organizing bookmarks. (Para. 0049).

9   The drawings in the Pitkow Patent Application Publication (US 2002/0016786) are

10   clearly not related to the disclosure of the publication and are not the drawings

11   filed with that application. The Pitkow Patent (US 7,031,961) contains the

12   drawings discussed in and filed with Pitkow's patent application. Accordingly, our

13   discussion of Pitkow's drawings is drawn to the drawings in the Pitkow Patent.

14   Pitkow teaches a system where bookmarks for a group of users are stored in a

15   bookmark database. (Para. 0050) By storing the bookmarks on a central server the

16   system allows for additional information concerning the bookmarks to be

17   presented such as whether the bookmarked page is available, is popular, or has

18   been recently updated. (Para. 0053). This information is presented alongside the

19   bookmark; see for figure 2, the icon, 228, in column 222, identifies that the

20   bookmarked web page is unavailable, the icon, 230, in column 224, identifies that

21   the bookmarked web page contains new content, and the icon, 232, in column 226,

22   identifies that the bookmark is popular. (Para. 0053-0055) Pitkow teaches that

23   popularity of the bookmark can be determined based upon how many other users

24   have the same bookmark or that other means of determining popularity may be

25   used such as frequency of use. (Para. 0055, 0086, 0097). Though Pitkow's system

26   primarily uses a bookmark server to store the bookmarks, Pitkow also teaches that

1 the bookmarks may be maintained on both a server and the user's local machine

2 and used in conjunction with a web browser. (Para. 0076, 0077). The user's local

3 machine queries the bookmark server when a user session begins to obtain the

4 information about the bookmarks. The user's machine also notifies the bookmark

5 server if the user has made any changes to the list of bookmarks. Pitkow also

6 teaches that the bookmark server may be used in providing web searches. (Para.

7 0103).

8 Ryan teaches a search engine for the internet. The system considers several

9 factors in determining whether a web site meets the users search criteria. One of

10 the measures is a measure of popularity based upon the number of times a web site

11 is visited. Number of times accessed is referred to as number of hits value "x," see

12 column 11, line 56 through column 12, line 31, tables 2 and 3, popularity in

13 general is also discussed in col. 20-23. Ryan also teaches that results from a search

14 may be saved in a manner similar to bookmarking. See column 20, lines 46-53 and

15 column 23, lines 20-32.

16

17   PRINCIPLES OF LAW

18   As was recently described in *In re Kahn*, 441 F.3d 977, 78 USPQ2d 1329

19 (Fed. Cir. 2006):

20   [T]he "motivation-suggestion-teaching" test asks not
21   merely what the references disclose, but whether a person
22   of ordinary skill in the art, possessed with the
23   understandings and knowledge reflected in the prior art,
24   and motivated by the general problem facing the
25   inventor, would have been led to make the combination
26   recited in the claims. From this it may be determined
27   whether the overall disclosures, teachings, and
28   suggestions of the prior art, and the level of skill in the
29   art – i.e., the understandings and knowledge of persons

1   having ordinary skill in the art at the time of the
2   invention-support the legal conclusion of obviousness.
3   (internal citations omitted).

4 *Id.* at 988, 78 USPQ2d at 1337. To establish a prima facie case of obviousness, the

5 references being combined do not need to explicitly suggest combining their

6 teachings. *See id.* at 987-88, 78 USPQ2d at 1337-38 ("the teaching, motivation, or

7 suggestion may be implicit from the prior art as a whole, rather than expressly

8 stated in the references"). "'The test for an implicit showing is what the combined

9 teachings, knowledge of one of ordinary skill in the art, and the nature of the

10 problem to be solved as a whole would have suggested to those of ordinary skill in

11 the art.'" *Id.* at 987-88, 78 USPQ2d at 1336 (quoting *In re Kotzab,* 217 F.3d 1365,

12 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

13   ANALYSIS

14   Claim 1 recites "means for tracking the rates of said bookmarked Web

15 documents transmitted from each of said sources ... displaying in association with

16 a displayed list of bookmarks for Web documents, data on rates of transmission of

17 said bookmarked documents." Independent claims 13 and 25 recite similar

18 limitations. As mentioned above Pitkow teaches displaying at the user's machine,

19 a list of bookmarks along with an indication of popularity. Pitkow does not

20 determine the popularity based upon transmission rates of the web document from

21 the source. Appellants admit, on page 7 of the Brief, that Ryan teaches tracking

22 transmission rates of web documents at the source. Further, as discussed *supra,*

23 Ryan teaches that tracking transmission rates is used in determining popularity.

24 Given these two documents we find that one skilled in the art would have been led

25 to the claimed invention of tracking web transmission of a document at the source

26 to determine popularity and display the popularity along with the bookmark. Thus,

1 contrary to Appellants' arguments, we find ample evidence to support the

2 Examiner's finding that the combination of Ryan and Pitkow teach the claimed

3 invention, and we sustain the Examiner's rejection of independent claims 1, 13,

4 and 25.

5   Appellants provide a separate argument directed to dependent claims 3

6 through 6, 15 through 18, and 27 through 30. In this argument Appellants concede

7 that Ryan teaches the various techniques for determining activity for web sites and

8 argue that Ryan does not teach applying these techniques to bookmarks (Br. 8). As

9 discussed above we find ample evidence to suggest applying Ryan's methods of

10 tracking popularity of a web site into bookmarks. Thus, Appellants' arguments

11 have not convinced us of error in the Examiner's rejection of claims 3 through 6,

12 15 through 18, and 27 through 30. Accordingly, we sustain the Examiner's

13 rejection of claims 3 through 6, 15 through 18, and 27 through 30.

14   Appellants provide a separate argument directed to dependent claims 9

15 through 12, 21 through 24, and 33 through 36. In these arguments Appellants

16 assert that the claims are directed to web browsers associated with reviewing

17 stations whereas Ryan is concerned with search engines which typically perform a

18 different function. As such Appellants reason that Ryan is inapplicable to the

19 claimed invention. (Br. 9). As discussed above Pitkow teaches a system of

20 managing bookmarks that can be on the users' local machine, which is used in

21 conjunction with a web browser. Further, as discussed above we find ample

22 evidence to suggest applying Ryan's methods of tracking popularity of a web site

23 into bookmarks. Thus, Appellants' arguments have not convinced us of error in

24 the Examiner's rejection of claims 9 through 12, 21 through 24, and 33 through 36.

25 Accordingly, we sustain the Examiner's rejection of claims 9 through 12, 21

26 through 24, and 33 through 36.

1   Appellants have presented no separate arguments directed to dependent

2   claims 2, 8, 13, 14, 20, 25, 28, and 32. Accordingly we affirm these claims for the

3   reasons discussed with respect to independent claims 1, 13, and 25.

4   On pages 9 and 10 of the Brief, Appellants argue that the rejection of claims

5   7, 19, and 31 under 35 U.S.C. § 103(a) as unpatentable over Ryan, Pitkow, and

6   Burke is in error for the same reasons given with respect to the base claims. As

7   Appellants' arguments have not convinced us of error in the Examiner's rejection

8   of claims 6, 18, and 30 (the claims upon which claims 7, 19, and 31 depend) we are

9   similarly not persuaded of error in the Examiner's rejection of claims 7, 19, and 31.

10
11   CONCLUSION

12   Appellants' arguments have not persuaded us of error in the Examiner's

13   rejections of claims 1 through 36 under 35 U.S.C. § 103(a). Accordingly, we

14   sustain these rejections. The decision of the Examiner is affirmed. We designate

15   our affirmance of the Examiner's rejection as new grounds of rejection under

16   37 CFR § 41.50(b), as our rationale differs slightly from that expressed by the

17   Examiner and because the figures of Pitkow which we rely upon were not made

18   available to Appellants prior to our decision.

19   This decision contains a new ground of rejection pursuant to 37 CFR

20   § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004),

21   1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides

22   "[a] new ground of rejection pursuant to this paragraph shall not be considered

23   final for judicial review."

1   37 CFR § 41.50(b) also provides that the Appellants, <u>WITHIN TWO</u>

2   <u>MONTHS FROM THE DATE OF THE DECISION</u>, must exercise one of the

3   following two options with respect to the new ground of rejection to avoid

4   termination of the appeal as to the rejected claims:

5   (1) *Reopen prosecution.* Submit an appropriate amendment of the
6   claims so rejected or new evidence relating to the claims so rejected,
7   or both, and have the matter reconsidered by the examiner, in which
8   event the proceeding will be remanded to the examiner. . . .

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10   (2) *Request rehearing.* Request that the proceeding be reheard under
11   § 41.52 by the Board upon the same record. . . .

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13   <u>AFFIRMED</u>
14   <u>37 CFR § 41.50(b)</u>

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23   VOLEL EMILE
24   INTERNATIONAL BUSINESS MACHINES CORPORATION
25   INTELLECTUAL PROPERTY LAW DEPARTMENT
26   11400 BURNET ROAD, INTERNAL ZIP 4054
27   AUSTIN TX 78758